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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,256	07/15/2001	Hidekazu Tanaka	AA374F	7253

27752 7590 09/10/2003

THE PROCTER & GAMBLE COMPANY
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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/10/2003

76

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/868,256	Applicant(s) TANAKA ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt is acknowledged of Amendment filed on June 18, 2003. Claims 1, 2, and 4-10 are pending. Claim rejections as indicated in the previous Office action dated December 18, 2002 are maintained for the reasons of record.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sumida (English translation of Japanese Kokai application no. HEI 4[1992]-48925) in view of Motono (US 4985455), or alternatively, in view of Sugizaki (English translation of Japanese Kokai application no. 3-115208).

Rejection is maintained for the reasons of record.

2. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyanagi et al. (U.S. Pat. No. 5474776) ("Kayanagi") in view of Motono, or alternatively, in view of Sugizaki.

Rejection is maintained for the reasons of record.

Response to Arguments

Applicant's arguments filed June 18, 2003 have been fully considered but they are not persuasive.

Regarding the obviousness rejection over Sumida in view of Motono, applicants argue that there is no motivation to look for a combination of surfactants allegedly because a microfluidizer is required to make a microemulsion. Examiner finds the

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argument unpersuasive because the required use of a particular microemulsion equipment does not suggest or imply that the equipment can replace the surfactants that are necessary in forming a desired microemulsion.

Furthermore, examiner respectfully disagrees with applicants' argument that the absence of tetra alkyl esters in the Sumida reference constitutes a teaching away from using the surfactant in the composition. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the motivation to add the surfactants of Motono should be analyzed in view of the collective teachings of the both Sumida and Motono references. Applicants further argue that the reference to the clarity of the Motono emulsion is to the intermediate product and that there is no mention of transparency of the final composition. Examiner notes that the applicants claimed composition requires oil, water, surfactants, and polyhydric alcohols. The Motono reference in Example 3 teaches that the intermediate product, which is a transparent emulsion (i.e., microemulsion), is formed by mixing PEO sorbitol tetraoleate, oil, water, and butylenes glycol (polyhydric alcohol), among others. Thus, the reference provides sufficient teaching that applicants' claimed components are old and well known in microemulsion cosmetic art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the rejection is based on the objective teachings of the prior art that the recited components of the instant claims are old and well known in making microemulsions, and not based on applicants' disclosure. Thus the rejection is proper.

Regarding the rejection over Sumida in view of Sugizaki, applicants argue that the prior art teaches examples having only 0.5 % of water, while the claimed inventions require at least 60% of water. Examiner notes that instant claims 1-7 does not recite any water amount. Claim 8 requires the water amount. Nonetheless, the rejection recites that the motivation to use the polyoxyethylene sorbitol tetraoleic acid ester for its particular traits useful in water and oil emulsion. The Sugizaki reference specifically teaches, for example, on page 3, third paragraph, that using the proper amount of the surfactant solubilizes oil and gives transparency and stability to the composition. Applicants' arguments against the rejection over Koyanagi in view of Sugizaki are found unpersuasive for an analogous reason.

Regarding the rejection over Koyanagi in view of Motonu, applicants assert that Koyanagi does not contemplate the use of additional amphoteric surfactant. Examiner finds the argument unpersuasive because the reference in fact teaches using POE tetraoleate in the composition. The reference simply fails to provide particular

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motivation to select the ester. The presence of anionic surfactant in the Koyanagi invention is not relevant because the scope of the instant claims is open to include other components not recited in the claims. See "comprising" in claims 1 and 8, line 1. While applicants further assert that the water content of the Koyanagi invention varies, the prior art in fact teaches the applicants' claimed range of the water amount.

Applicants further argue that it would take number of experiments to finally produce any composition. It is well settled in patent law that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the rejection is made under obviousness standard, as the references do not provide the exact formulation as claimed by the applicants. Examiner asserts that the burden of the Office to establish a prima facie obviousness case is to show that the collective teachings of the prior arts would have motivated a skilled artisan to make the claimed invention, which examiner believes has been met.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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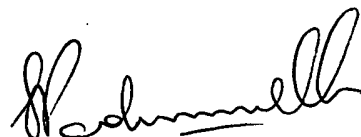
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner


SREENI PADMANABHAN
PRIMARY EXAMINER 9/4/03